

ESTTA Tracking number: **ESTTA1104578**Filing date: **12/28/2020**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following parties oppose registration of the indicated application.

Opposers Information

Name	Tennessee Football, Inc
Granted to Date of previous extension	12/27/2020
Address	800 SOUTH GAY STREET SUITE 2021 KNOXVILLE, TN 37929 UNITED STATES

Name	NFL Properties LLC
Granted to Date of previous extension	12/27/2020
Address	345 PARK AVENUE NEW YORK, NY 10154 UNITED STATES

Name	Houston Oilers LLC		
Entity	Corporation	Citizenship	Delaware
Address	460 GREAT CIRCLE ROAD NASHVILLE, TN 37228 UNITED STATES		

Attorney information	DALE M. CENDALI KIRKLAND & ELLIS LLP 601 LEXINGTON AVENUE 44TH FLOOR NEW YORK, NY 10022 UNITED STATES Primary Email: dale.cendali@kirkland.com Secondary Email(s): shanti.conway@kirkland.com, eric.loverro@kirkland.com, erika.dillon@kirkland.com, karina.patel@kirkland.com 212-446-4800
Docket Number	

Applicant Information

Application No.	88585845	Publication date	06/30/2020
Opposition Filing Date	12/28/2020	Opposition Period Ends	12/27/2020
Applicant	Alpha Entertainment LLC		

	1266 EAST MAIN STREET STAMFORD, CT 06902 UNITED STATES
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Goods/Services Affected by Opposition

Class 025. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Clothing, namely, tops and bottoms as clothing; headwear; sports caps and hats;t-shirts; shirts; sweatshirts; shorts; tank tops; sweaters; pants; jackets; golf shirts; knit shirts; jerseys; wristbands as clothing; warm up suits; gloves; ties as clothing; cloth bibs; sleepwear, namely, bathrobes and pajamas; underwear; socks; footwear, namely, sneakers, slippers, flip flops; scarves; bandannas; swimwear; Halloween and masquerade costumes
Class 041. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Entertainment services in the nature of professional football games and exhibitions; providing sports and entertainment information via a global computer network, mobile applications, commercial on-line computer service or by cable, satellite, television and radio; arranging and conducting athletic competitions, namely, professional football games; production and distribution of radio and television programs in the field of sports; entertainment services in the nature of live shows featuring football games, organizing live exhibitions, competitions, and live musical and dance performances; organizing sports competitions in the nature of sporting activities, namely, football skills competitions and football showcases; distribution of television programming to cable and satellite television systems; distribution of television programs for others; entertainment services, namely, providing online electronic games; football fan club services; providing a web site featuring sports news and entertainment news; Entertainment services in the nature of a fantasy football game

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2476024	Application Date	05/20/1997
Registration Date	08/07/2001	Foreign Priority Date	NONE
Word Mark	TENNESSEE OILERS INAUGURAL SEASON 97		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1997/08/01 First Use In Commerce: 1997/08/01 men's, women's and children's clothing,namely, T-shirts, [tank tops,] and caps		

U.S. Registration No.	1809126	Application Date	08/31/1992
Registration Date	12/07/1993	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1970/09/00 First Use In Commerce: 1970/09/00 trading cards, [posters,] [magazines relating to football,] [postcards, calendars, wrapping paper, paper gift boxes, paper stickers, paper napkins, paper		

	<p>towels,] [books relating to football,] [posterbooks,] notepads, [paper party hats and greeting cards]</p> <p>Class 025. First use: First Use: 1970/02/00 First Use In Commerce: 1970/02/00 men's, women's and children's clothing [and footwear;] namely, [coaches caps, wool hats, painters caps,] baseball caps, [visors, headbands, ear muffs, knit face masks, belts, wristbands,] T-shirts, [tank tops, pajamas, golf shirts, sweaters, sweatshirts, jackets, neckties, suspenders, cloth bibs, jerseys, night-shirts, coats, robes, raincoats, parkas, ponchos, sneakers, gloves, scarves, snow suits, mittens, aprons, down jackets, leather jackets, shorts, sweatpants, jeans, pants, knickers, socks, underwear, bathing suits and leg warmers]</p>
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Attachments	Notice of Opposition.pdf(197238 bytes)
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Signature	/Dale M. Cendali/
Name	Dale M. Cendali
Date	12/28/2020

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 88/585,845



For the mark:

Filed: August 20, 2019

Published: June 30, 2020

NFL PROPERTIES LLC, HOUSTON
OILERS LLC, and TENNESSEE
FOOTBALL, INC.,

Opposers,

v.

ALPHA OPCO, LLC,

Applicant.

Opposition No.

NOTICE OF OPPOSITION

NFL Properties LLC (“NFLP”), a corporation organized and existing under the laws of Delaware with a principal place of business at 345 Park Avenue, New York, NY 10154, **Houston Oilers LLC** (“Oilers”), a corporation organized and existing under the laws of Delaware with a principal place of business at 460 Great Circle Road, Nashville, TN 37228, and **Tennessee Football, Inc.** (“Titans Club”), a corporation organized and existing under the laws of Delaware with a principal place of business at 800 South Gay Street, Suite 2021, Knoxville, TN 37929, (collectively, “Opposers”), believe that they will be damaged by the issuance of a registration for



the service mark underlying Application Serial No. 88/585,845, (“Applicant’s Mark”), for goods in Classes 25 and 41, and hereby oppose the same.

As grounds for their opposition, Opposers allege as follows, with knowledge concerning their own acts, and on information and belief as to all other matters:

INTRODUCTION

1. On August 20, 2020, Alpha Entertainment LLC filed use-based Application Serial No. 88/585,845 to register Applicant's Mark for "[c]lothing, namely, tops and bottoms as clothing; headwear; sports caps and hats; t-shirts; shirts; sweatshirts; shorts; tank tops; sweaters; pants; jackets; golf shirts; knit shirts; jerseys; wristbands as clothing; warm up suits; gloves; ties as clothing; cloth bibs; sleepwear, namely, bathrobes and pajamas; underwear; socks; footwear, namely, sneakers, slippers, flip flops; scarves; bandannas; swimwear; Halloween and masquerade costumes" in International Class 25 and "[e]ntertainment services in the nature of professional football games and exhibitions; providing sports and entertainment information via a global computer network, mobile applications, commercial on-line computer service or by cable, satellite, television and radio; arranging and conducting athletic competitions, namely, professional football games; production and distribution of radio and television programs in the field of sports; entertainment services in the nature of live shows featuring football games, organizing live exhibitions, competitions, and live musical and dance performances; organizing sports competitions in the nature of sporting activities, namely, football skills competitions and football showcases; distribution of television programming to cable and satellite television systems; distribution of television programs for others; entertainment services, namely, providing online electronic games; football fan club services; providing a web site featuring sports news and entertainment news; Entertainment services in the nature of a fantasy football game" in International Class 41 (collectively, "Applicant's Services").

2. On August 21, 2020, Alpha Entertainment LLC assigned its entire interest and goodwill in Applicant's Mark, among other things, to Alpha Opco, LLC ("Applicant").

3. Applicant's Mark is not registrable because it so closely resembles Opposers' well-



known Houston Oilers "Oil Derrick" trademark (the "Oilers Mark"), as to be likely to cause confusion, mistake, or deception in the minds of consumers as to the origin, sponsorship or source of Applicant's Services or the affiliation between Applicant and Opposers in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

OPPOSERS AND THE OILERS MARK

4. NFLP is the licensing arm of the National Football League ("NFL"), which controls the licensing and merchandising for the NFL's 32 member clubs and related entities.

5. The Titans Club is a member of the NFL and a professional football team based in Nashville, Tennessee, which was known as the Houston Oilers prior to relocating to Nashville in 1997.

6. Since at least as early as 1970, Opposers have extensively promoted, marketed, advertised, distributed, and sold goods and services in connection with the Oilers Mark, which is inherently distinctive and also has acquired secondary meaning.



7. The Oilers Mark is recognized by football fans across the country and has become associated with Opposers in connection with football-related goods and services, including entertainment services in the nature of professional football games and exhibitions, as well as various merchandise such as apparel.

8. Although the Houston Oilers moved to Tennessee and changed its name to the Tennessee Titans, the Oilers Mark still retains valuable goodwill and consumer recognition. For instance, NFLP provides a number of clothing and other products via an online retail portal where consumers may purchase goods bearing the Oilers Mark, located at <https://www.nflshop.com>, as shown below:



9. Moreover, the Titans Club has paid homage to its roots by wearing helmets with the Oilers Mark during professional football games.

10. Opposers own registered trademarks in the United States for, and extensive common law rights to, the Oilers Mark, including:

TRADEMARK	REG. NO.	REG. DATE	GOODS/SERVICES (FIRST USE/PRIORITY DATE)
	2,476,024	August 07, 2001	Class 25: Men's, women's and children's clothing, namely, T-shirts, [tank tops,] and caps (first use August 1, 1997)
	1,809,126	December 7, 1993	<p>Class 16: Trading cards, [posters, magazines relating to football, postcards, calendars, wrapping paper, paper gift boxes, paper stickers, paper napkins, paper towels, books relating to football, posterbooks,] notepads [, paper party hats and greeting cards] (first use September 1970)</p> <p>Class 25: Men's, women's and children's clothing [and footwear;] namely[, coaches caps, wool hats, painters caps,] baseball caps, [visors, headbands, ear muffs, knit face masks, belts, wristbands,] T-shirts[, tank tops, pajamas, golf shirts, sweaters, sweatshirts, jackets, neckties, suspenders, cloth bibs, jerseys, night shirts, coats, robes, raincoats, parkas, ponchos, sneakers, gloves, scarves, snow suits, mittens, aprons, down jackets, leather jackets, shorts, sweatpants, jeans, pants, knickers, socks, underwear, bathing suits and leg warmers] (first use February 1970)</p>

11. The Oilers Mark is valid and in full force and effect. Indeed, affidavits have been filed and accepted pursuant to Sections 8 and 9 of the Lanham Act for Registration No. 1,809,126, and Sections 8, 9, and 15 for Registration No. 2,476,024, rendering such registrations incontestable.

APPLICANT AND ITS APPLICATION

12. Applicant owns and operates the XFL, a professional football league formed in 2019 consisting of eight football teams, including the Houston Roughnecks (“Roughnecks”), a football team located in Houston, Texas.

13. Notwithstanding Opposers’ prior rights, and well after Opposers obtained common law rights and registrations for the Oilers Mark, Applicant filed its application to register Applicant’s Mark as the primary logo for the Roughnecks, as shown below:



14. Opposers filed, first used in commerce, and registered the Oilers Mark prior to the August 20, 2019 filing date of Applicant’s application.

15. Applicant adopted, attempted to use, and applied to register Applicant’s Mark with knowledge of Opposers’ Oilers Mark and Opposers’ rights thereto.

16. By attempting to obtain a trademark registration in a logo for Applicant’s Houston-based football team that unequivocally mimics the logo of the famous Houston Oilers, Applicant

is making a clear attempt to draw on the goodwill and recognition that Opposers have built up over five decades of use, which Opposers enjoy to this day.

17. Applicant's adoption of Applicant's Mark was willful and with knowledge of Opposers' prior trademark rights. Applicant's adoption of Applicant's Mark was intended to trade off on the goodwill that Opposers have built in the Oilers Mark.

LIKELIHOOD OF CONFUSION

18. Consumers encountering Applicant's Mark, particularly in connection with Applicant's Services, are likely to associate the mark with Opposers, based on the similarity of the parties' marks and their respective goods and services.

19. Applicant's Mark is highly similar visually to, and creates a highly similar overall commercial impression as, Opposers' Oilers Mark. As shown below, the similarities are apparent, and go far beyond simply showing an oil derrick. The Oilers' Mark contains a depiction of an oil derrick with two levels and crossing bars throughout, and utilizes the colors red, white and blue. Similarly, Applicant's Mark also contains a depiction of an oil derrick with two levels and crossing bars throughout, and utilizes the colors red, white and blue.

The Oilers Mark:



Applicant's Mark:



20. In addition, Applicant's application to register Applicant's Mark covers services highly similar and complementary to Opposers' products and services, including Opposers' online

retail offerings for clothing and merchandise bearing the Oilers Mark, as well as entertainment services in the nature of professional football games and exhibitions.

21. Opposers thus will be damaged by the registration of Applicant's Mark, as Applicant's Mark and Applicant's Services are confusingly similar to the Oilers Mark and the goods and services that Opposers offer in connection thereto.

22. Specifically, if Applicant is granted the registration herein opposed, it would thereby obtain a *prima facie* exclusive right to use Applicant's Mark in connection with Applicant's Services. Such registration would conflict with Opposers' trademark rights and be a source of damage and injury to Opposers.

WHEREFORE, Opposers request that this opposition be sustained and that the registration of Application Serial No. 88/585,845 in connection with Applicant's Services be denied.

Dated: December 28, 2020

Respectfully submitted,
Kirkland & Ellis LLP

By: /s/ Dale M. Cendali

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CERTIFICATE OF SERVICE

I hereby certify that on December 28, 2020, I caused a true and correct copy of the foregoing **NOTICE OF OPPOSITION** to be served via email upon the following individuals:

Joel E. Tragesser
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Counsel for Applicant

Dated: December 28, 2020

/s/ Dale M. Cendali
Dale M. Cendali